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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,887	02/08/2002	Murali Rajagopalan	20002.0236	9994

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/09/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/067,887

Applicant(s)

RAJAGOPALAN ET AL

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

Application 9-225341 (6084016) issued prior to the filing date of the instant application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support claim 31's E/X/Y structure and the amounts of Y.

The specification does not support the 60,000 psi limitation of claims 21 and 39.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1712

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22, 24, 39 and 43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the WO 96/40826 Patent.

The reference adds oxa acids to golf ball covers. The cover can be made of surlyn 7930 which has a flex modulus of 67,000 psi (table 1). The resulting cover has a hardness and flex modulus meeting applicant's claim 24.

The cover can also be made of high acid ionomer such as surlyn AD 8422 (page 10 line 37). Surlyn AD 8422 has an acid content between 18.5 – 21.5% (see Sullivan '304 col. 12 lines 17-22).

Claims 21, 22, 24-27, 39 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the WO 96/40826 Patent in view of WO 96/40377 or Sullivan '553.

The primary reference does not suggest density adjusting fillers in the cover.

These additives are well known to one of ordinary skill (see WO 96/40377 page 19 lines 3-17). These fillers control moment of inertia (see col. 3 lines 15-42 of Sullivan).

It would have been obvious to add density adjusting fillers to the WO 96/40826 cover for the expected advantages.

Claim 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the WO 96/40826 Patent in combination with Sullivan '304.

WO 96/40826 teaches ionomeric golf ball covers containing oxa acids, but does not measure COR or compression of the balls.

The claimed COR and compression are conventional values for commercial golf balls (see table 4 of Sullivan). It would have been obvious to ensure the balls of WO 96/40826 are within normal ranges.

Alternatively, it would have been obvious to add an oxa acid to the Sullivan balls of table 3 which have the claimed COR and compression. The oxa acid is expected to provide good spin (see abstract of WO 96/40826).

Claims 21-25, 28-41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sullivan '237 Patent in view of WO 96/40826 or WO 98/43713.

Sullivan discloses three layer golf balls. Example 6 show a ball having Iotek 959 in the inner cover and a urethane outer cover. Iotek 959 has a flex modulus of 66,000 psi (col. 7 line 25). The high acid ionomer in the inner cover

Art Unit: 1712

can also have some softening termonomer (col. 5 line 47). Additional materials can be added to the inner cover (col. 18 line 39) although oxa acids are not specifically mentioned.

Oxa acids are known to be additives to ionomeric golf ball layers (see WO 96/40826 and WO 98/43713). It would have been obvious to include an oxa acid in Sullivans inner cover for the expected advantages.

Claims 21-26, 31-34, 37-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the WO 96/40377 Patent in view of WO 96/40826 or WO 98/43713.

The primary reference discloses golf balls having a cover of an E/X/Y ionomer (page 7 line 16). The flex modulus can be up to 150,000 psi (col. 7 line 28). Additional components can be included (pages 18-19) although oxa acids are not specifically mentioned.

Oxa acids are known to be additives to ionomeric golf ball layers (see WO 96/40826 and WO 98/83713). It would have been obvious to include an oxa acid in Sullivans inner cover for the expected advantages.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1712

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-27, 30-34 and 36-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent No. 6391955. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims golf ball layers of oxa ester and a saponified polymer (an ionomer) in claim 25. The flex modulus can be up to 100,000 psi (claim 30).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1712

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER  
PRIMARY EXAMINER

D. Buttner/mn  
April 8, 2003

*David Buttner*